

REMARKS/ARGUMENTS

In the Office Action dated March 8, 2005, the Examiner: 1) rejected claims 40-41, 45, and 51 under 35 U.S.C. § 112, second paragraph; 2) rejected claims 1-5, 7, 15-16, 18-20, 22-25, and 59-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,866,492, issued to *Knoll* (hereinafter *Knoll*) in view of U.S. Patent No. 6,230,591, issued to *Ling et al.* (hereinafter *Ling*); 3) rejected claims 8-11, 14, 27-44, 46-50, 52, 54-56, and 58-61 under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in view of DE 299 07 467 (hereinafter *Hsieh*); 4) rejected claims 6, 17, and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in view of *Ling* and U.S. Patent No. 4,903,554, issued to *Colvin* (hereinafter *Colvin*); 5) rejected claims 12 and 57 under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in view of *Hsieh* and *Colvin*; 6) rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in view of *Hsieh*, *Colvin*, and *Ling*; and 7) rejected claim 53 under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in view of *Hsieh* and *Ling*. The Applicants respond as follows.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 40-41, 45, and 51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 40-41, 45, and 51 have been cancelled.

Rejections under 35 U.S.C. 103(a)

Claims 1-20, 22-44, 46-50, and 52-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Knoll* in combination with one or more of *Ling*, *Colvin*, and *Hsieh*. Claims 8-14 and 27-61 have been cancelled so as to more clearly focus on the elements of the claims at issue.

The Applicant reserves the right to continue prosecution of the cancelled claims in additional applications as appropriate.

Claims 1, 15, and 23 are the remaining independent claims. Claims 2-7 depend from claim 1. Claims 16-20 and 22 depend from claim 15. Claims 24-26 depend from claim 23. Claims 1, 15, and 23 are each rejected as being unpatentable over *Knoll* in view of *Ling*. Therefore, the following discussion will focus on the combination of *Knoll* and *Ling* and why that combination does not render obvious claims 1, 15, and 23.

The Examiner asserts that *Knoll* discloses all of the claimed limitations except for a pawl that is rotatable about the gear wheel axis, a pawl that abuts against the first or second wall portions, the pawl teeth forming a substantially concave surface, and a top surface with a hole. The Examiner then relies on *Ling* to teach the limitations not found in *Knoll*. The Examiner reasons that “(i)t would have been obvious to one having ordinary skill in the art to form the device of *Knoll* such that the pawl pivots about the gear wheel axis to change the direction of rotation of the ratchet and provide a high torque with a minimum free rotating angle useful in a limited space using a ratcheting action as taught by *Ling et al.*”

Knoll teaches a torque wrench that shifts from a torque multiplier mechanism to a direct-drive mechanism once predetermined torque value is reached. Col. 1, Lines 45-55. In contrast, *Ling* teaches a ratcheting tool having a reversing mechanism that allows the ratcheting direction of the tool to be changed. Col. 5, Lines 35-43. The Examiner’s reliance on *Ling* to teach the desirability of modifying the device of *Knoll* “to change the direction of rotation of the ratchet and provide a high torque” is insufficient. Since the device of *Knoll* is not designed to ratchet why would one skilled in the art be motivated to convert it into a ratcheting tool. Further, it is unclear why one skilled in the art would want to modify the pawl of *Knoll* to provide a higher torque since the pawl (106) of *Knoll*

only engages the gear wheel teeth (104) the device is shifted into a direct-drive mode that limits the torque applied and a higher strength pawl would be unnecessary.

The Applicant contends that since the device of *Knoll* is a non-ratcheting torque wrench and the device of *Ling* is a reversible ratcheting wrench, the combination of the pawl from *Ling* and the device of *Knoll* would not have been obvious without some distinct teaching that would motivate a combination of a ratcheting pawl into a non-ratcheting tool. It appears that the Examiner has improperly used hindsight in selecting elements from references in distinctly different technologies, while discarding other teachings of the references, and combining those elements in a way not suggested by the prior art but motivated only by an attempt to find all of the limitations of the claims. Because the Examiner has failed to cite sufficient teachings to motivate the combination of a non-ratcheting, torque-multiplying tool and a reversible ratcheting tool to form the claimed invention, claims 1, 15, and 23 are allowable over the cited combination.

Further, courts have held that if the proposed combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims obvious. MPEP § 2143.01 *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Claims 1, 15, and 23 have been amended to further define the first position as being where the first teeth portion of the pawl engages the gear wheel for ratcheting in a first direction, and further define the second position as being where the second teeth portion of the pawl engages the gear wheel for ratcheting in a second direction.

The Applicant asserts that modifying the tool of *Knoll* as suggested by the Examiner would significantly change the principle of operation of the *Knoll* tool by converting the tool from a torque-multiplying tool to a reversible ratcheting tool. Because claims 1, 15, and 23 clearly claim a reversible ratcheting tool, the modification of the non-ratcheting tool of *Knoll* that is proposed by the

Examiner is not sufficient to render the claims obvious. Therefore, claims 1, 15, and 23 are allowable over the cited combination.


Claims 2-7 depend from claim 1. Claims 16-20 and 22 depend from claim 15. Claims 24-26 depend from claim 23. Because each of claims 1, 15, and 23 are allowable over the cited art, claims 2-7, 16-20, 22, and 24-26 are also allowable.

Conclusions

During the course of these remarks, Applicant has at times referred to particular limitations of the claims which are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction.

If the Examiner has any questions or comments regarding this communication, he is invited to contact the undersigned to expedite the resolution of this application.

Respectfully submitted,



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